No. 94-1437

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

CONOPCO, INC. d/b/a
CHESEBROUGH-POND'S USA CO.,

Petitioner,

vs.

MAY DEPARTMENT STORES COMPANY, VENTURE STORES, INC., THE BENJAMIN ANSEHL COMPANY, and KESSLER CONTAINERS, LTD.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF AND BRIEF OF THE BRISTOL-MYERS SQUIBB COMPANY AS AMICUS CURIAE IN SUPPORT OF THE PETITION

PAUL W. CANE, JR.
PAUL HASTINGS JANOFSKY & WALKER
555 South Flower Street
Los Angeles, California 90071
(213) 683-6000

SAMUEL D. ROSEN*
LAWRENCE I. WEINSTEIN
BRENDAN J. O'ROURKE
PAUL HASTINGS JANOFSKY & WALKER
399 Park Avenue
New York, New York 10022
(212) 318-6000

Attorneys for Amicus Curiae

**Counsel of Record*

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MOTION FOR LEAVE TO FILE BRIEF AND BRIEF OF THE BRISTOL-MYERS SQUIBB COMPANY AS AMICUS CURIAE IN SUPPORT OF THE PETITION

The Bristol-Myers Squibb Company ("**Bristol**") hereby moves, pursuant to Rule 37.2 of the Rules of this Court, for leave to file the attached brief amicus curiae in support of the petition for certiorari. Counsel for petitioner Conopco, Inc. ("**Conopco**") has consented to the filing of this brief.* However, counsel for the respondents have each withheld consent.

Bristol is one of the largest manufacturers of over-the-counter pharmaceutical preparations, health and beauty aids and personal and hair care products in the United States. Its products, which include such famous household names as EXCEDRIN®, BUFFERIN® and NUPRIN® analgesics, BAN® antiperspirants, the CLAIROL® line of hair care products, and KERI® skin care lotions, are sold in virtually every supermarket, drug store and mass merchandiser in this country. In each of these marketplaces, Bristol's products face fierce but fair competition. In some stores, the competition is only from other national manufacturers, such as petitioner Conopco. In others, Bristol also faces competition from the store's own brands, also known as "private label" brands.

To catch the consumer's eye amidst the cacophony of the modern day retail marketplace, and to distinguish its products from the like products of its competitors, Bristol has spent hundreds of millions of dollars to develop and promote distinctive and recognizable trade dress for each of its products. As a result of these vast expenditures, consumers

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* A copy of the consent letter is being filed concurrently with the Clerk of the Court.

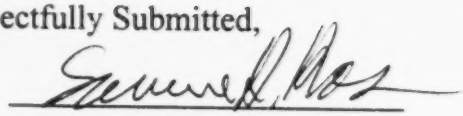
have come to associate this trade dress with the safety, efficacy and overall high quality of Bristol's products. Thus, over the course of time, the trade dress of Bristol's products has become an invaluable corporate asset.

That asset, and the like assets of scores of other consumer product manufacturers, has been placed in severe jeopardy by the Federal Circuit's 2-1 decision that is the subject of Conopco's petition. In *Conopco*, the panel majority expressly authorized retailers selling their own private label products in competition with national brands to slavishly copy the latter's trade dress, so long as the retailer's own name or logo appears on the package. The majority's holding not only creates an irreconcilable conflict between the Federal Circuit and other Circuits, but also fundamentally ignores this Court's recent teachings in *Two Pesos, Inc. v. Taco Cabana, Inc.*, _____ U.S. _____, 112 S. Ct. 2753 (1992), as to the critical importance trade dress plays in the selection of goods by consumers. *Conopco* doubtless will embolden other private label manufacturers to copy the famous trade dress of their national brand competitors, and thus deceive consumers in ways that other Courts of Appeals have held to violate the Lanham Act, but to which the Federal Circuit gave its blessing.

In short, *Conopco* fundamentally affects the vital interests of Bristol, of other manufacturers of national consumer brands, and of U.S. consumers. In Bristol's case, the consequences of the Federal Circuit's decision are particularly disturbing, because Bristol sells a variety of high quality over-the-counter drug products, the indicia of origin of which should not be placed in the hands of others over whom Bristol has no control. For the above reasons, Bristol respectfully requests leave to file the attached brief, and urges this Court to grant Conopco's petition and reverse the decision below.

Dated: March 28, 1995
New York, New York

Respectfully Submitted,

By: 

SAMUEL D. ROSEN*

LAWRENCE I. WEINSTEIN
BRENDAN J. O'ROURKE
PAUL HASTINGS JANOFSKY
& WALKER
399 Park Avenue
31st Floor
New York, New York 10022
(212) 318-6000

PAUL W. CANE, JR.
PAUL HASTINGS JANOFSKY
& WALKER
555 South Flower Street
23rd Floor
Los Angeles, California 90071
(213) 683-6000

Attorneys for Amicus Curiae

* *Counsel of Record*

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INTEREST OF AMICUS

Amicus The Bristol-Myers Squibb Company ("**Bristol**") respectfully refers this Court to the description of its interest presented in its annexed motion for leave to file this brief.

REASONS FOR GRANTING THE WRIT/ SUMMARY OF POSITION

This Court and each of the Courts of Appeals to have addressed the issue have recognized the critical importance of trade dress to both manufacturers and consumers.[1] To the manufacturer, which often spends millions of dollars developing and promoting it, the trade dress associated with its products is a vital and extraordinarily valuable aspect of its business. To the consumer, trade dress is an important -- often *the most important* -- means of quickly distinguishing his or her product of choice from the sea of competitive products during what is typically a hurried shopping expedition.

In this case, a divided panel of the Federal Circuit, purporting to apply Eighth Circuit law, reversed a decision of the United States District Court for the Eastern District of Missouri reached after an eight-day bench trial. The majority held that Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), permits retailers that market both their own private label store brand and a competing national brand to deliberately copy the national brand's trade dress, so long as the retailer's own house mark or logo is also somewhere affixed to the package. The majority's holding is premised on a fundamental disregard of how trade dress affects consumer purchasing decisions and of the different types of actionable consumer confusion that result when one party pirates another's distinctive trade dress. The Federal Circuit's decision creates a clear conflict among the Circuits. The panel majority ignored two well-established lines of cases which recognize that certain types of consumer confusion cannot be prevented by a

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[1] Trade dress is the overall appearance of a product or its packaging, including color scheme, shape, size, graphic presentation and other stylized elements.

retailer's use of its own mark in conjunction with the competitor's mark or trade dress that the retailer copied or simulated. For example, the Federal Circuit ignored the kind of customer confusion that results (and that the trial court found as a fact would likely result here) when a product, even though understood by consumers not to *be* the national brand, is thought to be authorized, licensed or sponsored by the national brand ("sponsorship" or "association" confusion). Similarly, the Federal Circuit also ignored the kind of consumer confusion that results when copycat trade dress catches the consumer's eye in the store, even if, by the time of purchase, the consumer realizes that the product is not in fact the national brand (so-called "foot-in-the-door" confusion).

Congress enacted Section 43(a) of the Lanham Act to create a uniform federal standard to protect consumers from marketplace confusion and to protect manufacturers from unfair competition caused by the "deceptive and misleading use" of trademarks and trade dress. Thus, any conflict among the Circuits as to whether a particular type of activity violates the Lanham Act necessarily frustrates Congress's goal. Moreover, the conflict engendered by the decision of the *Conopco* panel majority is especially serious, because trade dress copying by private label manufacturers is an increasingly common phenomenon. Unless reversed, the Federal Circuit's decision cannot help but encourage more private label manufacturers to become copyists, and will, at a minimum, foster confusion among national brand and private label manufacturers as to the latter's rights to deliberately simulate the former's well-known trade dress. Trade dress copying will severely harm national brand manufacturers such as Conopco and Bristol, whose substantial financial investments in the development of proprietary trade dress and associated good will are threatened with misappropriation without compensation, and whose good will and reputations for high quality products will be placed in the hands of copyists over whom

the national brand manufacturers have no control. Trade dress piracy will also injure American consumers, who the Federal Circuit has now held to be fair game for marketing tactics that other federal appellate and trial courts have denounced as deceptive and unfair.

Review Is Necessary To Resolve A Conflict Among The Circuits

A. The Relevant Legal And Factual Context Of The *Conopco* Decision

As this Court recently held, Congress enacted the Lanham Act "to make 'actionable the deceptive and misleading use of marks' and 'to protect persons engaged in commerce . . . against unfair competition.' " *Two Pesos, Inc. v. Taco Cabana, Inc.*, ____ U.S. ____, 112 S. Ct. 2753, 2757 (1992), *quoting* Lanham Act § 45, 15 U.S.C. § 1127. In *Two Pesos*, this Court expressly recognized the importance to both manufacturers and consumers of a uniform nationwide law prohibiting trade dress infringement and held that the Lanham Act protects trade dress to the full extent that it protects trademarks:

> Protection of trade dress, no less than of trademarks, serves the [Lanham] Act's purpose to "secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers. National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefit of good reputation."

112 S. Ct. at 2760, *quoting Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198 (1985).

To prevail on a claim for trade dress infringement, a plaintiff must first establish a protectable interest in its trade dress. *See Two Pesos,* 112 S. Ct. at 2757-58. If it meets that test, as petitioner did here, 784 F. Supp. at 677 (Petition at 78a-79a), it then must establish a likelihood that consumers will be deceived or confused by the similarity of the defendant's trade dress. 112 S. Ct. at 2763 (Stevens, J., concurring). The Courts of Appeals have applied materially identical tests for determining whether a likelihood of confusion exists. These tests require evaluation of various factors, including (1) the strength of the plaintiff's mark or trade dress; (2) the degree of similarity of the parties' marks or trade dress; (3) the similarity of the parties' products; (4) the competitive proximity of the products; (5) the defendant's intent; and (6) instances of actual confusion. *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980); *see, e.g., Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961); *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978); *Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1330 (7th Cir. 1977), *cert. denied*, 434 U.S. 1070 (1978); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

Proof that defendant intentionally copied plaintiff's mark or trade dress creates a powerful presumption that one or more types of actionable consumer confusion will result.[2] This

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[2] *Perfect Fit Indus., Inc. v. Acme Quilting Co.*, 618 F.2d 950, 954 (2d Cir. 1980), *cert. denied*, 459 U.S. 832 (1982) ("If there was intentional copying, the second comer will be presumed to have intended to create a confusing similarity of appearance and will be presumed to have succeeded"); *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464, 467 (2d Cir.), *cert. denied*, 350 U.S. 832 (1955) (intentional copying "gives rise to a powerful inference that confusion is likely, and puts on the alleged infringer the burden of going forward with proof that it is not"). *Accord, Osem Food Indus. Ltd. v.*

(Footnote continued)

presumption dates back nearly to the beginning of the century, to the Second Circuit's common sense observation that:

> "It is so easy for the honest businessman, who wishes to sell his goods upon their merits, to select from the entire material universe which is before him, symbols, marks and coverings, which by no possibility can cause confusion between his goods and those of his competitors, that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his successful rival that the public may fail to distinguish between them."

Florence Mfg. Co. v. J.C. Dowd & Co., 178 F. 73, 78 (2d Cir. 1910). Several decades later, Judge Learned Hand reached the equally common sense conclusion that, since the intentional copyist "is intimately concerned with the probable reaction in the market, his judgment manifested prior to the controversy" that copying the first comer to the market would be of commercial benefit to the copyist, "is highly persuasive" that consumer confusion will indeed result. *American Chicle Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 563 (2d Cir. 1953), *quoting* Restatement of Torts § 729 comment (e) (1938).

Sherwood Foods, Inc., 917 F.2d 161, 165 (4th Cir. 1990) ("When a newcomer to the market copies a competitor's trade dress, its intent must be to benefit from the goodwill of the competitor's customers by getting them to believe that the new product is either the same, or originates from the same source as the product whose trade dress was copied"); *Academy of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir. 1991) ("When one party knowingly adopts a mark similar to another's, reviewing courts presume that the defendant will accomplish it purpose, and the public will be deceived"); *Bauer Lamp Co. v. Shaffer*, 941 F.2d 1165, 1172 (11th Cir. 1991) (same holding).

As set forth in detail in Conopco's petition, the trial court found as a fact that Conopco's trade dress for Vaseline Intensive Care Lotion (**"Vaseline Intensive Care"**) was a strong mark; that respondents deliberately set out to copy the Vaseline Intensive Care trade dress; that in doing so, numerous potential designs were rejected as not appearing similar enough to the Vaseline Intensive Care trade dress; that respondent Venture chose not to put its own name on the front of its private label package, but did place the Vaseline Intensive Care mark, complete with trademark registration symbols, on the front of the package; and that the trade dress that respondents ultimately adopted was extremely similar to that of Vaseline Intensive Care. 784 F. Supp. at 659-61, 664, 666-67, 678 (Petition at 42a-44a, 54a, 56a-57a, 80a).

B. The Majority's Holding

The Federal Circuit did not disturb any of those factual findings. Nonetheless, it held, with one judge dissenting, that the trial court committed clear error in its ultimate finding that consumer confusion would likely occur. Dismissing the trial court's factual findings as to the similarity of the parties' trade dress and respondents' intentional copying as "at best merely inferentially or presumptively relevant to the likelihood of confusion," 32 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1994) (Petition at 16a), the majority expressly endorsed respondents' copying of Conopco's trade dress as a legitimate way to hawk a message of product comparability:

> This is a case in which a retailer markets a national brand product and at the same time markets its own private label product in direct competition. The retailer packages its product in a manner to make it clear to the consumer that the product is similar to the national brand, and is intended for the same purposes. At the same time, the retailer clearly

> marks its product with its private logo, and expressly invites the consumer to compare its product with that of the national brand, by name . . . . We are unwilling to attribute to the Eighth Circuit, absent clear precedent so requiring, a rule that would make such competition presumptively unlawful.

32 U.S.P.Q.2d at 1231 (Petition at 15a).

An essential aspect of the majority's analysis was its assumption that the only type of consumer confusion relevant to a likelihood of confusion analysis was "confusion about whose product was whose," 32 U.S.P.Q.2d at 1232 (Petition at 18a), *i.e.*, whether respondents' trade dress was likely to cause consumers to purchase the Venture private label skin care lotion in the mistaken belief that they had actually selected a bottle of Vaseline Intensive Care. Concluding that even in the absence of the Venture name on the front of the private label bottle, the presence of the Venture logo on the front of the bottle made that type of confusion unlikely, 32 U.S.P.Q.2d at 1231-32 (Petition at 16a-17a), the Federal Circuit reversed the trial court's determination that respondents were liable under Section 43(a) for trade dress infringement.

C. The Federal Circuit's Decision Creates A Conflict Among The Circuits

Petitioner Conopco is absolutely correct that the Federal Circuit's holding -- that a store selling its own private label brand may freely copy the trade dress of a national brand to communicate product comparability or otherwise to invite consumer comparison if the store displays its own trademark or logo on the private label product or package -- conflicts with the Second Circuit's decision in *Oral-B Labs., Inc. v. Mi-Lor Corp.*, 810 F.2d 20, 22-23 (2d Cir. 1987). There, the Second Circuit expressly rejected the argument that the private label manufacturer of a store brand toothbrush could

copy the trade dress of ORAL-B, a national toothbrush brand, to evoke consumer comparison of the store brand with ORAL-B, or could avoid liability for trade dress infringement by adding to the private label package, as respondents did in the case at bar, "the name of [the] retailer" and a statement inviting the consumer to "COMPARE WITH ORAL-B."

In like manner, as petitioner informs this Court (Petition at 12 n.9), the Federal Circuit's decision is also inconsistent with federal district court cases holding that it is a violation of the Lanham Act for retailers to copy the trade dress of national brands on competing private label products, notwithstanding that the retailer's name appears on the package of the copycat product. *E.g.*, *Kroger Co. v. Johnson & Johnson*, 570 F. Supp. 1055 (S.D. Ohio 1983) (store brands' mimicking of the distinctive TYLENOL trade dress and trademark violated the Lanham Act, notwithstanding that the copycat packaging bore the names of the well-known supermarket and drug store chains Kroger and Super X); *Ziegenfelder Co. v. Dunkirk Ice Cream Co.*, 30 U.S.P.Q.2d 1604 (N.D. W.Va. 1993) (preliminary injunction granted in case involving private label's copying of major brand's trade dress even though private label's trademark appeared on the copyist's package). *Kroger* is especially instructive. There, like here, retailers deliberately copied the packaging of a well-known national brand in order that the retailers' store brands would be "reminiscent" of the national brand in shoppers' minds. 570 F. Supp. at 1057 n.4. In enjoining the retailers from using their copycat packaging, the court clearly recognized what the Federal Circuit in *Conopco* simply missed:

> There is something inherently unfair in the effort by [the retailers] to avail themselves of the name and good will of Tylenol. [Johnson & Johnson has] expended millions of dollars in advertising [its] product to the American public. To permit a

> bystander who has spent a minimum of time, money, and effort in developing its product to profit by marketing the identical commodity with a similar name and packaging is contrary to the stated Congressional purpose of the Lanham Act.

Id. at 1060.

Moreover, Bristol respectfully submits that petitioner has in fact understated the extent and scope of the inter-circuit conflict engendered by the Federal Circuit's decision. In holding that petitioner could not prevail without proving that consumers were likely to buy the Venture store brand product in the mistaken belief that they were buying Vaseline Intensive Care, the Federal Circuit utterly disregarded the relevance of two other equally pernicious kinds of consumer confusion that are spawned by trade dress piracy, that were found by the trial court to be present in this case, and that other federal appellate and district courts have held to be actionable under the Lanham Act.

1. The Federal Circuit Ignored A Long Line Of Cases Recognizing "Sponsorship" Or "Association" Confusion

The first such kind of confusion is confusion as to association or sponsorship, in which consumers recognize at the time of purchase that defendant's product is being sold under a brand name other than plaintiff's, but are induced to believe that plaintiff has manufactured, sponsored or authorized defendant's product because of defendant's use of a trademark or trade dress that closely mimics or copies plaintiff's. *E.g.*, *Lois Sportswear, U.S.A., Inc. v. Levi Strauss*, 799 F.2d 867, 872 (2d Cir. 1986) (Lanham Act violation occurs even where consumer realizes at the point of purchase that he is not buying LEVI's jeans, but is nonetheless confused by defendant's use or emulation of plaintiff's proprietary trade dress or marks

into believing that [defendant] either somehow is associated with [plaintiff] or has consented to [plaintiff's] use of its trademark"); *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976) (likelihood of confusion established where consumer is likely to believe that defendant's enterprise "may in some way . . . be connected or affiliated with, or sponsored by" plaintiff); *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769, 774 (8th Cir. 1994), *cert. denied*, ___ U.S. ___, 115 S. Ct. 903 (1995), *quoting* McCarthy, *Trademarks and Unfair Competition* § 24.03, at 24-13 (3d ed. 1992) (under Lanham Act, "an expansive interpretation of likelihood of confusion" is appropriate, extending 'protection against use of plaintiff's mark on any product or service which would reasonably be thought by the buying public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner' "); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398 (8th Cir. 1987), *cert. denied*, 488 U.S. 933 (1988) (likelihood of confusion as to whether plaintiff "has sponsored, endorsed or is otherwise affiliated with" defendant's design establishes liability under Section 43(a)).

In amending Section 43(a) of the Lanham Act in 1988, Congress made explicit that the statute prohibited conduct likely to cause confusion as to "affiliation, . . . association . . . , sponsorship, or approval . . . ."[3] The trial court found as a fact that respondent's packaging created a likelihood of confusion as to sponsorship. 784 F. Supp. at 682-83 (Petition at 89a-90a).

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[3] As amended in 1988, 15 U.S.C. § 1125(a) (1) prohibits acts in commerce that are "likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . ." (Petition at 3).

2. The Federal Circuit Ignored The Line Of Cases Recognizing "Foot-In-The-Door" Confusion

The second such type of confusion, often referred to as "foot-in-the-door" confusion, is the explicit goal of the private label copyist, who deliberately uses the familiar trade dress of a famous brand to call a consumer's attention, either consciously or subliminally, to the private label product. In such circumstances, the consumer is initially attracted to and induced to consider purchasing a private label brand that he or she would not otherwise have considered buying, because of the private label's attention-getting use of the established brand's well-known trade dress or trademark -- a ploy similar to the prohibited practice of bait and switch. In *Conopco*, the trial court found as a fact that this was precisely what respondents intended. 784 F. Supp. at 666 (Petition at 56a).

Federal courts have long recognized that "borrowing" a competitor's trademarks or trade dress, and the good will attendant thereto, to compete against the trademark or trade dress owner, is unfair competition in violation of the Lanham Act even where, by the time the consumer ultimately purchases the copyist's product, he or she realizes that it is not the established brand. In *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf v. Steinway & Sons*, 523 F.2d 1331 (2d Cir. 1975), the Second Circuit affirmed an injunction for infringement of the famous Steinway trademark for pianos, notwithstanding the absence of any proof that at the time of purchase, consumers mistakenly believed they were buying Steinway pianos. An injunction was warranted, the Court of Appeals found, because defendant's adoption of a similar mark would likely cause "subliminal confusion . . . as to the relationship . . . between the corporate entities and the products that can transcend the competence of even the most sophisticated consumer" who, having been "[m]isled into an

initial interest" in the junior user's product, might elect to buy it even after recognizing it to be a different brand. *Id.* at 1341.

Similarly, in *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259 (2d Cir. 1987), the Second Circuit found a likelihood of confusion respecting defendant's use of the word Pegasus as the trade name for its oil company, where a graphic nonverbal presentation of Pegasus is Mobil's famous trademark. The Court of Appeals concluded that confusion was likely, not because a third party would ultimately contract with defendant "believing it is related to Mobil, but rather in the likelihood that [defendant] would gain critical credibility during the initial phases of a deal" as a result of a fleeting association caused by the similar images of the parties' marks. *Accord, Playboy Enterprises, Inc. v. Chuckleberry Publishing, Inc.*, 486 F. Supp. 414, 428 (S.D.N.Y. 1980), *aff'd*, 687 F.2d 563 (2d Cir. 1982) (PLAYMEN for men's magazine infringes PLAYBOY mark, not because consumers will be duped into believing they are buying PLAYBOY Magazine, but rather because defendant's "exploiting [a] subliminal or conscious association with plaintiff's well-known name" may motivate consumers to buy PLAYMEN who would not otherwise have done so had the magazine carried a different name); *McDonald's Corp. v. McBagel's, Inc.*, 649 F. Supp. 1268, 1273-74, 1279 (S.D.N.Y. 1986) (enjoining use of McBagel's mark for bagel restaurant even though consumers would readily recognize, well before even entering defendant's restaurant, that it was not McDonald's. Injunction issued because use of "Mc" mark would cause consumers to associate defendants "however fleetingly, with plaintiff's goods, services, sponsorship or other support," and thus to eat at McBagel's whereas, absent defendant's use of the closely similar mark, consumers may never have noticed defendant's business.)

As the above cases reflect, the placement of a junior user's trademark on trade dress that the junior user copied from the senior user in no way eliminates the risk of associational or "foot-in-the-door" confusion. Thus, the Federal Circuit's conclusion in *Conopco* -- that the presence of the Venture logo on respondent's packages is sufficient to dispel any likelihood of confusion -- is squarely at odds with a long line of federal appellate and district court decisions holding precisely to the contrary. For example, in *W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 662 (2d Cir. 1970), plaintiff, the owner of the mark "Trim" for a manicuring tool, sued Revlon for infringement based on Revlon's use of the mark "Revlon's Cuti-Trim" for a similar product. Although defendant's packaging prominently featured the famous Revlon mark, the Second Circuit affirmed judgment for plaintiff, holding that "Revlon's reliance on the fact that it uses its well-known name along with 'Cuti-Trim' is misplaced" because this "tactic could well show that Revlon was seeking . . . to couple the benefits of the 'Trim' mark with the persuasive powers of its own name, and thus the tactic could not ensure against, but might indeed promote, confusion." *Accord*, *Coach Leatherware Co. v. AnnTaylor, Inc.*, 933 F.2d 162, 1970 (2d Cir. 1991) (infringement found in defendant's emulation of plaintiff's well-known style of tag affixed to leather handbags, notwithstanding that plaintiff's and defendant's well-known names appeared on their respective tags); *Badger Meter v. Grinnell Corp.*, 13 F.3d 1145, 1152 (7th Cir. 1994) (finding of likelihood of confusion affirmed despite presence of house labeling on defendant's product); *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1540 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987) (presence of defendant's mark on its goods does not prevent finding of trade dress infringement); *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 698 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982) (same

holding); *Le Sportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 79 (2d Cir. 1985) (same holding).[4]

Critically, the Federal Circuit's decision in *Conopco* ignores these substantial precedents and expressly approves a practice that the federal courts previously had widely condemned -- a copyist's deliberate simulation of another's well-known, familiar mark or trade dress as a marketing device designed to call attention to the copyist's product. As these courts have recognized, hitching a free ride on the packaging recognition that another manufacturer has labored long and at great expense to develop is precisely the type of unfair competition that Congress, in enacting the Lanham Act, sought to prohibit.

CONCLUSION

The decision of the *Conopco* panel majority is a frontal assault on the rights of national brand manufacturers to protect their investment in the development of proprietary trade dress from piracy by private label competitors, and an open invitation for retailers marketing private label brands to make free use of the good will that national brand manufacturers have invested vast sums to develop. Nor will consumers benefit from this misguided attempt at Robin Hood justice: quite to the contrary, the sleight of hand practices to which the Federal Circuit has

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[4] *See also Veryfine Prods., Inc. v. Colon Bros., Inc.*, 799 F. Supp 240, 252 (D.P.R. 1992) (presence of defendant's mark on challenged packaging does not dispel likelihood of confusion); *Kraft General Foods, Inc. v. Friendship Dairies*, 19 U.S.P.Q.2d 1691, 1693-94 (S.D.N.Y. 1991) (likelihood of confusion found as to trade dress of sour cream containers notwithstanding that both cartons displayed their respective manufacturer's well-known brand names); *Ciba-Geigy Corp. v. Bolar Pharmaceutical Co.*, 547 F. Supp. 1095, 1102-03 (D.N.J. 1982), *aff'd*, 719 F.2d 56 (3d Cir. 1983), *cert. denied*, 465 U.S. 1080 (1984) (infringement found even though defendant's corporate logo was imprinted on look-alike generic drugs).

now given its approval have routinely been viewed by other federal courts as profoundly deceptive and unfair.

The *Conopco* decision is not only at odds with the expansive scope of trade dress protection under the Lanham Act which this Court recognized in *Two Pesos*, but is also in hopeless conflict with the decisions of other Courts of Appeals. Amicus Bristol respectfully requests that this Court grant Conopco's petition, resolve this conflict and reverse the Federal Circuit's decision.

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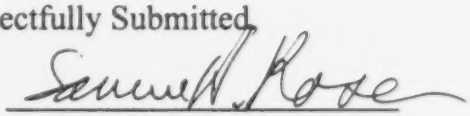
New York, New York

Respectfully Submitted,

By: 
SAMUEL D. ROSEN*

LAWRENCE I. WEINSTEIN
BRENDAN J. O'ROURKE
PAUL HASTINGS JANOFSKY
& WALKER
399 Park Avenue
31st Floor
New York, New York 10022
(212) 318-6000

PAUL W. CANE, JR.
PAUL HASTINGS JANOFSKY
& WALKER
555 South Flower Street
23rd Floor
Los Angeles, California 90071
(213) 683-6000

Attorneys for Amicus Curiae

* *Counsel of Record*